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U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Allied-Sysco Food Services, Inc.  
v.  
The Pizza Maker, Inc.

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Cancellation No. 21,309  
Cancellation No. 21,321

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Paula D. Morris of Rosenblatt & Associates for Allied-Sysco  
Food Services, Inc.

Mark O'Brien, President of The Pizza Maker, Inc., for The  
Pizza Maker, Inc.

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Before Cissel, Hanak and Hohein, Administrative Trademark  
Judges.

Opinion by Cissel, Administrative Trademark Judge:

Registration 1,606,637 issued to respondent on the  
Principal Register on July 17, 1990 for the mark shown below

for "franchising services, namely, offering technical  
assistance in the establishment and/or operation of pizza

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restaurants," in Class 35, and "restaurant services," in Class 42. The words "THE PIZZA MAKER" were disclaimed apart from the mark as shown. First use in 1979 was claimed. Less than a year after the first registration was issued to respondent, on March 17, 1992, Registration No. 1,679,573 issued on the Principal Register to the same corporation. The mark there is "THE PIZZA MAKER!" and the goods are specified as "pizza."<sup>1</sup> The registration sets forth the claimed date of first use of that mark as December 28, 1979.

Separate petitions to cancel these two registrations were filed by the same petitioner on November 10, 1992. The two proceedings were subsequently consolidated, and both were argued in one set of briefs based on a single record. No oral hearing was requested.

The sole ground asserted by petitioner for cancellation of respondent's registrations is abandonment on the basis of nonuse. Responsive to the petitions to cancel, respondent denied that it had abandoned use of the registered marks.

Petitioner's standing is established by petitioner's use of, and applications<sup>2</sup> to register, the mark "PIZZA MAKER" for products involved in making pizza. Petitioner's applications to register its mark were refused registration based on the existence of respondent's registrations, and prosecution of both applications

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<sup>1</sup>No disclaimer was offered by the applicant or required by the Examining Attorney, however.

<sup>2</sup>S.N. 74/372,789 and 74/373,002 were filed on March 29, 1993.

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has been suspended pending resolution of the instant cancellation proceedings.

Respondent's president, who apparently is not an attorney and is not familiar with either the Trademark Rules of Practice or the Federal Rules of Civil Procedure which are used in proceedings of this nature before the Trademark Trial and Appeal Board, represented his corporation without benefit of counsel. This fact appears to be one reason for the protracted problems with discovery and the overly extensive record presented to the Board in this case, which, at the time this decision is being reached, has been pending for over six years. Petitioner's counsel is commended for the patience and flexibility displayed in trying to abide by the rules without unnecessarily confusing respondent.

The record in this proceeding includes the following: the testimony, with exhibits, of Mark O'Brien, taken April 27, 1994; the testimony, with exhibits, of Steve Rosenblatt, taken May 3, 1994; the testimony, with exhibits, of Elise Ciokajlo, taken April 27, 1994; the testimony, with exhibits, of Steven Noon, taken June 20, 1994; and the documents and exhibits specified in petitioner's notice of reliance, filed May 9, 1994.

Respondent takes the position in its brief that the testimonial deposition of Mr. O'Brien taken on June 6, 1994, the testimonial deposition of Mr. Damante taken June 20, 1994 and the testimonial deposition of Mr. Burke taken July 1, 1994 also form parts of the record before the Board, but petitioner has objected based on the fact that respondent did not comply with Trademark Rule 2.125(c) by serving petitioner and filing with the Board a

notice that this testimony and the associated exhibits had been filed with the Board. Respondent has not argued to the contrary, and the record does not reflect the filing of the notice with either the Board or petitioner. Accordingly, the additional testimony and exhibits to which petitioner has objected have not been considered. We note for the record, however, that even if we were to consider them, our decision would not be different.

Although some of the testimony, evidence and argument of respondent appears to be directed to whether confusion is likely between petitioner's mark, as used with petitioner's goods and services, and respondent's mark, as used with the goods and services set forth in the challenged registrations, likelihood of confusion within the meaning of Section 2(d) of the Lanham Act is not an issue in either one of these consolidated cancellation proceedings. The sole issue pleaded by petitioner and tried by the parties is whether or not respondent abandoned use of the marks in connection with the goods and services set forth in the registrations.

The fundamental legal principles applicable to this issue are not seriously disputed. Section 14(3) of the Lanham Act provides for cancellation of a registration at any time if the mark has been abandoned. Section 45 of the Lanham Act provides, in pertinent part, that a mark has been abandoned "[w]hen its use has been discontinued with the intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for two consecutive years shall be prima facie evidence of abandonment. 'Use' of a mark means the bona fide use of that mark made in the

ordinary course of trade, and not made merely to reserve a right in a mark."<sup>3</sup>

Based on careful consideration of the record in the case at hand, we have reached the conclusion that the registered marks were abandoned by respondent. This record does not contain any evidence that the goods or services set forth in the registrations were provided under the marks during the two years immediately preceding the filings of these petitions to cancel. Further, respondent has not established that its nonuse was excusable. The record does show that respondent may have resumed at least token use of the marks again after petitioner filed the petitions for cancellation of the registrations, and it shows that respondent would certainly like to sell petitioner the right to use the registered marks, but this does not overcome the evidence that the marks were abandoned, nor does it somehow lead to the conclusion that respondent's rights to the registrations were revived after petitioner had begun using its mark during the period when respondent had stopped using its marks.

The testimony of Mr. Noon establishes that petitioner began using its "PIZZA MAKER" mark on cheese in December of 1990, and that petitioner since then has expanded the line of products on which it uses the mark to include a wide variety of both goods and

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<sup>3</sup>While we note that, as of January 1, 1996, Section 45 was amended to provide that a period of three consecutive years of nonuse, instead of a two-year period, constitutes prima facie abandonment, we have applied the two-year standard, since these proceedings were commenced prior to January 1, 1996, so as not to give retroactive effect to the statutory amendment. See *Clairol Inc. v. Compagnie D'Editions et de Propagande du Journal La Vie Claire-Cevic*, 24 USPQ 1224, 1226 (TTAB 1992).

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services. Petitioner's annual sales under the mark exceed a million dollars.

The record is far less clear concerning respondent's use of the two registered marks. At one time, respondent may well have been using them in connection with the goods and services set forth in the registrations. The record contains no evidence to the contrary. The issue before the Board concerns what use respondent made of its registered marks in the two years prior to the November, 1992 filing of the petitions to cancel.

Several facts raise the inference that by November of 1992, respondent had abandoned whatever rights it had in the registered marks. Perhaps the most fundamental of these facts is that before 1990, respondent had a license from the Oakland County, Michigan, Health Department to operate a retail food establishment at respondent's address on Elizabeth Lake Road in Union Lake, Michigan, but that license was not renewed in 1990, 1991, or 1992. After these proceedings were instituted, an application was filed, but if respondent actually operated a food establishment there during the period in question, it did so unlawfully, without a license.

At the time petitioner was made aware of the registrations owned by respondent, petitioner conducted an investigation to determine if the registered marks were in use. To that end, during the summer of 1992, Steve Rosenblatt, counsel for petitioner, called the telephone number which respondent contends is the number for its business there on Elizabeth Lake Road. Mr. Rosenblatt's testimony is that the phone was answered by an

answering machine, and the announcement was "Hi, this is Mark O'Brien. I'm not home right now, but if you leave a message, I'll get back to you." This message is inconsistent with respondent's contention that the telephone was used in conducting an ongoing pizza restaurant business. Moreover, it is certainly not evidence of the use of the registered marks on the goods or services set forth in the registrations.

Further testimony reveals that when Mr. Rosenblatt contacted Mr. O'Brien and requested evidence that the registered marks were in use in connection with the sale of the goods and services set forth in the registrations, rather than sending the usual evidence of an ongoing business, such as invoices from customers or vendors of raw materials, or even current advertising, Mr. O'Brien mailed petitioner's lawyer a box containing a piece of dry ice and a pizza, with a piece of paper bearing a photocopy of one of the registered marks taped onto the box. Also included was an invoice for fifty dollars. Mr. Rosenblatt sent the package back to Mr. O'Brien without payment, but Mr. O'Brien proceeded to create a deposit record on which he noted that the fifty dollar deposit was being made by Mr. O'Brien because Mr. Rosenblatt did not pay for the pizza! Thus by his own account, Mr. O'Brien put his own money in his business' account in an attempt to document a sale which never occurred. This testimony and evidence falls far short of establishing that the registered marks were in use in connection with respondent's goods and services during the period in question.

The evidence, particularly the testimony and exhibits of Ms. Ciokajlo, show that there was no ongoing business at respondent's business address. Although several photocopied reproductions of the marks were displayed on the premises by the time her testimony was given, the free-standing sign along the road next to the building was totally blank. There was no seating for diners inside the facility. There was no indication that even a carry-out restaurant was operating there. There was no evidence that respondent was rendering franchising services from that location. The record does not include any evidence concerning any sales transactions, any receipts, any expenditures for materials, equipment or employees' salaries during the period in question, or any tax returns reflecting ongoing business activity during the period, much less evidence that the goods and services set forth in the registrations were marketed by respondent during the period in question under the registered marks. There is no evidence whatsoever that respondent was using the mark in connection with franchising services. Not a single contract or other agreement for these services is of record, nor is there even any credible testimony that such agreements existed or that these services were rendered to anyone under the registered mark.

Notwithstanding Mr. O'Brien's self-serving testimony that his corporation was using the marks in connection with the goods and services during this period, there is no corroborating evidence of record. The record is replete with attempts by petitioner to get respondent to provide proof of the use it claims during the period petitioner questions, but respondent steadfastly refused to



support its contention with documentary evidence. In view of the fact that respondent, rather than petitioner, is uniquely in the position to have access to information and documentation concerning its use of its own marks, respondent's failure to substantiate its claim is significant. There may well have been a fundamental misunderstanding on the part of Mr. O'Brien concerning the requirement for him to provide petitioner with information and documentation establishing respondent's use or excusable nonuse, but whatever the reason was, respondent stubbornly refused to allow petitioner access to the information that might have met respondent's burden to overcome the evidence showing abandonment.

Petitioner argues that respondent should be considered to have admitted the facts supporting petitioner's claim of abandonment because respondent refused to respond to petitioner's discovery requests and requests for admissions concerning respondent's use during the times in question. Regardless of whether petitioner may be entitled to judgment in its favor on this technical procedural point, as discussed above, a careful evaluation of the record results in the inescapable conclusion that there is no evidence in support of respondent's contention that it used the registered marks in connection with the goods and services set forth in the registrations.

Respondent argues that a number of exhibits support its position, but in fact none of them does. Because evidence and information requested during discovery, but not produced then, may not be made of record later, we will discuss only respondent's evidence which was produced during discovery and the arguments

based upon that evidence, as best we understand such arguments, in the paragraphs which follow.

The affidavit of Lucille Yukon relates to the facts discussed above concerning the fact that Mr. O'Brien shipped a pizza to petitioner's attorney. As we noted, the shipment to Mr. Rosenblatt was not a sale at all, much less a sale or shipment in the ordinary course of commerce within the meaning of the Lanham Act.

The undated advertising materials do not establish that any pizza bearing the marks was actually sold during the period in question or that restaurant or franchising services were rendered under the mark.

Mr. O'Brien's affidavit is self-serving testimony that is not corroborated by any other testimony or evidence.

The receipts from "American Speedy Printing Centers" bear dates outside the period in question, and, in any event, they do not establish that goods were sold or services were rendered under the marks.

The copies of envelopes addressed to "The Pizza Maker, Inc." do not show that respondent sold goods or rendered services under the registered marks. These exhibits do not even show use of the tradename by respondent, much less that respondent used the registered trademarks in connection with the goods and services identified in the registrations.

The bills for personal property tax do not identify the property to which they relate. Mr. O'Brien either could not or would not say what the referenced property was. Even if the tax

bills specifically related to some equipment or materials which are typically used in connection with restaurant services or food products, the bills would not be evidence showing use of the marks in connection with the sale of goods or services under the marks during the period in question.

The remaining evidence to which respondent points as proof of the use of the mark are equally deficient. The undated copies of respondent's labels and fliers are not evidence of the use of the mark during the period in question. The telephone directory listing of respondent's business phone number, discussed above, does not show that goods or services were being provided under either of respondent's registered marks during the relevant period. A statement from an employee of American Speedy Printing Centers is to the effect that he had "conducted business over several years and at the present time continues to do business with THE PIZZA MAKER®! INC." The statement does not specify whether respondent procured printing services from Speedy Printing Centers or whether respondent's business provided goods or services to the printing business. The registered trademark of respondent appears in the statement with "INC." following it. As such, it is used as a trade name in reference to the corporate entity, rather than as an indication of the commercial source of respondent's pizza.

As petitioner frequently points out, no matter how many times respondent recites the foregoing materials, they still are not evidence that any pizza was actually sold or that any services were actually rendered at a commercial level under the marks

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during the relevant time. The showing by petitioner that respondent abandoned its marks is simply not rebutted by respondent's unsupported claims that it used the marks.

Accordingly, because respondent abandoned the marks, the petitions to cancel the registrations are granted and Registration Nos. 21,309 and 21,321 will be canceled in due course.

R. F. Cissel

E. W. Hanak

G. D. Hohein  
Administrative Trademark Judges  
Trademark Trial and Appeal Board

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